

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARDO CAPORICCIO

Appeal No. 1996-0098
Application No. 08/207,512¹

ON BRIEF

Before JOHN D. SMITH, GARRIS and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 5 and 7-12. Claim 4, which is the

¹ Application for patent filed March 8, 1994.

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only other remaining claim that is pending in this application has been indicated as allowable by the examiner (Final Rejection, mailed December 22, 1994).

BACKGROUND

The appellant's invention relates to a grease composition including fluorinated polymer oils and boron nitride. According to appellant, enhanced lubricating properties may be obtained if the boron nitride is utilized with a bimodal particle size distribution (Specification, page 3). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A grease composition comprising:

(A) between 5 and 45 weight percent of a thickening agent comprising boron nitride powder having a bimodal particle size distribution in which between 25 and 75 weight percent of the boron nitride has an average particle size in the range of from 2 to 50 micrometers and between 75 and 25 weight percent of the boron nitride has an average particle size in the range of from 0.01 to 1 micrometer; and

(B) between 55 and 95 weight percent of a liquid fluorinated polymer oil.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Hong	3,801,505	Apr.
02, 1974		
Christian et al. (Christian)	4,324,673	Apr.
13, 1982		
Takahashi et al. (Takahashi)	5,100,568	Mar.
31, 1992		
Caporiccio	5,210,123	May 11,
1993		

Claims 1-3, 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hong. Claims 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hong in view of Christian. Claims 1-3, 5 and 7-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caporiccio in view of Takahashi.

OPINION

Upon careful consideration of the opposing arguments presented on appeal, we concur with appellant that the applied prior art fails to establish a prima facie case of obviousness of the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, the

conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Appellant argues (Brief, pages 3-15) that the subject matter defined by the appealed claims cannot be found in the applied references. We agree. A pivotal flaw in all of the examiner's rejections is that none of the references relied upon teach or suggest the claimed bimodal particle size distribution of the boron nitride powder component utilized in appellant's grease composition.

Regarding the rejection utilizing Hong as the sole evidence of obviousness relied upon, the examiner urges that the claimed bimodal size distribution of the boron nitride would have been "within the broad teachings of Hong..." in that "[t]he boron nitride taught by Hong has a particle size of about one micron" (Answer, page 4). However, we agree with

appellant that Hong's single reference to a boron nitride particle size of about 1 micron (column 2, lines 9-11) clearly does not teach or suggest appellant's claimed bimodal size distribution that requires boron nitride particles of two distinct size ranges; but, rather suggests a substantially singular or uniform particle size of about 1 micron (Brief, page 6).

Since the examiner acknowledges that Christian does not even teach the use of boron nitride as a grease component (Answer, page 5), the addition of the latter reference to the teachings of Hong does not cure the above-noted deficiency. Accordingly, the examiner's § 103 rejection of claims 10 and 11 likewise falls short of presenting a prima facie case of obviousness.

Regarding the examiner's § 103 rejection of claims 1-3, 5 and 7-12 over the combined teachings of Caporiccio and Takahashi, we again observe that the applied references' teachings, even if combined, lack any specific teaching or suggestion of using a bimodal particle size distribution of boron nitride particles in a grease composition as claimed. While Takahashi does disclose employing boron nitride powder

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of "a size of from 0.1 to 50 micrometers" (column 3, lines 17-22) as a thickening agent, the patent does not suggest the use of two different particle size ranges of the powder as claimed. Moreover, in our view, the examiner has not furnished a convincing line of reasoning indicating why a skilled artisan would have found the claimed composition prima facie obvious from the combined reference teachings.

In short, the record before us does not support a conclusion that the examiner has met the burden of presenting a prima facie case of obviousness. From our perspective, the examiner's rejections appear to be premised on impermissible hindsight reasoning. It follows that we cannot sustain the examiner's stated § 103 rejections of the appealed claims.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH

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Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
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